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| 09/803,563 | 03/09/2001 | Raimond Lasar | 01LASR01PN | 7303 |

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EXAMINER

MELWANI, DINESH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3677

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,563

Applicant(s)

LASAR, RAIMOND

Examiner

Dinesh N Melwani

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-24 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-24, and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claim 18 is withdrawn in view of the newly discovered reference(s) to Kowalski (U.S. Patent No. 5,074,128). Rejections based on the newly cited reference(s) follow.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/803,563, filed on 03/09/01.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 4/9/03 is being considered by the examiner.

Acknowledgement is made of applicant's submission of:

Amendments B/C, which cancelled claims 18, 25, and 26 and added claims 27-31,
filed (completed) on 2/4/03.

The aforementioned item has been noted and officially inserted into the application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to what the applicant intends by reciting "said section with said section..." in line 6. For the purposes of examination, the Examiner has treated the aforementioned phrase as --said decorative section with said gradually increasing diameter section--.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

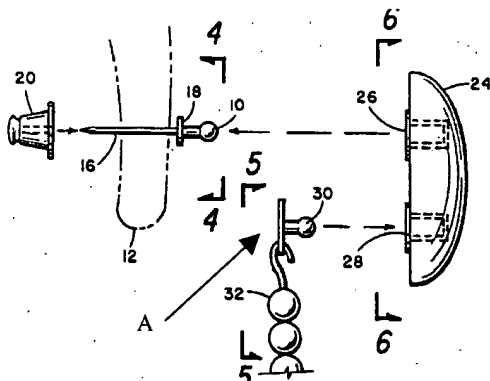
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 14, 15, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hernandez (U.S. Patent No. 4,783,974). Hernandez discloses a body decoration system as claimed; wherein said system comprises a body piercing section (16), said body piercing section having a primary end, a secondary end (10), and a diameter; a fastening section (20), said fastening section having a diameter, said diameter of said fastening section being greater than said diameter of said body piercing section, a primary attachment, said primary attachment of said fastening section being detachably related in mating engagement with said primary end of said body piercing section; a head section (24), said head section having a secondary attachment (26), said secondary attachment of said head section being attached to said secondary end of said body piercing section, a primary attachment (28), said primary attachment of said head section

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providing a detachable mating engagement; and a decorative section (A), said decorative section having a primary attachment (30), said primary attachment of said decorative section being detachably related in mating engagement so said primary attachment of said head section, a decorative element (32), said decorative element being affixed to said primary attachment of said decorative section; whereby said decorative section may be removed and replaced with a different section without removing said head section or said fastening section from said body piercing section, see figure below.



As it concerns claim 14, Hernandez's fastening section (20) is essentially spherical. Regarding claim 15, said body piercing section (16) is a piercing pin.

8. Claims 1, 2, 3, 6-10, 12, 13, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (U.S. Patent No. 4,195,492). Johnson discloses a body decoration system as claimed; wherein said system includes a body piercing section (2), said body piercing section having a primary end (4), a secondary end (12), and a diameter; a fastening section (6), said fastening section having a diameter, said diameter of said fastening section being greater than said diameter of said body piercing section, a primary attachment (8), said primary attachment of said fastening section being detachably related in mating engagement with said primary end of said body piercing section; a head section (15), said head section having a secondary attachment

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(S), said secondary attachment of said head section being attached to said secondary end of said body piercing section, a primary attachment (P), said primary attachment of said head section providing a detachable mating engagement; and a decorative section (14), said decorative section having a primary attachment (H), said primary attachment of said decorative section being detachably related in mating engagement so said primary attachment of said head section, a decorative element (Z), said decorative element being affixed to said primary attachment of said decorative section; whereby said decorative section may be removed and replaced with a different section without removing said head section or said fastening section from said body piercing section, see Fig. 1. As it concerns claim 2, Johnson's decorative section (14) includes an axis of rotational symmetry, said primary attachment (H) of said decorative section being disposed along said axis of said decorative section. The head section includes an axis of rotational symmetry, said primary attachment of said head section being disposed along said axis of said head section; said axis of said head section lying along a central axis of rotational symmetry and said axis of said decorative section also lying along a central axis of rotational symmetry; said head section having a flattened area being defined by a plane which is normal to said central axis of rotational symmetry. The flattened area having an external diameter, a portion forming a central hollow area, said hollow portion having an internal diameter, said hollow portion having a base point disposed along said axis of said head section, said external diameter being somewhat larger than said internal diameter, a substantially circular shaped stop area (G), said stop area being created between said internal diameter and said external diameter. The primary attachment of said head section being positioned at said base point of said hollow portion in said head section; said decorative section includes a ring-shaped fastening section (Q)

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attached to said decorative element; said ring shaped fastening section being substantially centered about said central axis of rotational symmetry; said ring shaped fastening section being in contact with said circular shaped stop area when said primary attachment of said decorative section is engaged with said primary attachment of said head section; whereby said decorative section is strengthened and supported by said head section when said decorative section is mated with said head section. As it concerns claim 3, Johnson's primary attachment of said head section includes a friction element, said friction element of said head section being frictionally related in mating engagement with said primary attachment of said decorative section. As it concerns claim 6, Johnson's detachable mating engagement of said decorative section includes a section with gradually increasing diameter, and said detachable mating engagement of said head section includes a spring element (16), said section with said section with gradually increasing diameter of said detachable mating engagement of said decorative section being related in releasable locking engagement with said spring element of said detachable mating engagement of said head section. In regards to claim 7, Johnson's primary attachment of said decorative section has a first diameter, and said decorative element (Z) of said decorative section has a second diameter, said first diameter of said primary attachment of said decorative section and said second diameter of said decorative element of said decorative section being related by a ratio of 1, see Figs. 1 and 2. The applicant is also reminded that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). In regards to claim 8, Johnson's central hollow area of said head section is essentially conical joint shaped, said decorative section is essentially conical joint shaped, said conically joint shaped decorative section including a tip, and said primary attachment of said

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decorative section being attached at said tip of said conically shaped decorative section, said tip of said conically joint shaped decorative section being detachably related in mating engagement with said primary attachment of said head section, fig. 1. Regarding claim 9, said decorative section includes a mounting, said mounting having a decorative element attachment point (W), and a primary attachment point (U), said decorative element being permanently attached to said decorative element attachment point, and said primary attachment of said head section being attached at said primary attachment of said decorative section mounting. In regards to claims 10 and 12, Johnson's body piercing section comprises a straight rod (2) having a circular cross-section. As it concerns claims 13 and 24, Johnson's primary end of said body piercing section includes external threading, and said primary attachment of said fastening section includes external threading, said primary end of said body piercing section being removably threadedly related in mating engagement with said primary attachment of said fastening section, see Fig. 1. For the purposes of clarification, the Examiner has interpreted the grooves (i.e., 13 in Fig. 1) that make up the "snap-on" connector as threads.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez (U.S. Patent No. 4,783,974) in view of Erickson (U.S. Patent No. 4,781,036). Hernandez

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discloses a body decoration system substantially as claimed, wherein attachments are made using friction engaging members instead of internal/external threading on respective members.

Erickson discloses an earring that teaches the use of identical internal and external threads as an art-recognized equivalent of frictional engaging members

11. Claims 19, 27, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez (U.S. Patent No. 4,783,974) in view of Kowalski (U.S. Patent No. 5,074,128).

Hernandez discloses a body decoration substantially as claimed (see paragraph 5 above) but fails to disclose the axis of the primary end of the body piercing section and the axis of the secondary end of the body piercing section forming an angle that is less than 180 degrees; wherein said angle is between 90 and 180 degrees. Kowalski discloses an earring having a body piercing section; wherein the angle claimed by the applicant is between 90 and 180 degrees, namely between 90 and 135 degrees. The applicant is reminded that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

12. Claims 20, 22, 23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hernandez (U.S. Patent No. 4,783,974) in view of Erickson (U.S. Patent No. 4,781,036), further in view of Kowalski (U.S. Patent No. 5,074,128). Claims 20, 22, 23, and 28 are rejected in view of Erickson and Kowalski and as set forth above in paragraphs 5, 7, and 8. For the purposes of clarification, Hernandez's head section comprises an outside diameter; portion forming a hollow area, said hollow area of said head section having an inside diameter, said inside diameter of said hollow area being essentially 20% smaller than the diameter of said head section. The applicant is also reminded that a change in the size of a prior art device is a design consideration within the

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skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), see fig. 6. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize, the teachings of Erickson, in regards to the use of identical internal/external threads as means of engagement, to provide Hernandez with a more secure and tactile means of engagement. The methods recited by the applicant in claims 22 and 23 are deemed inherent based on the structure of the prior art of record. Since the teachings of the references taken as a whole necessitate the steps described in said methods, it would have been obvious to one having ordinary skill in the art at the time the invention was made to carry out the necessary steps described by the methods.

13. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 4,195,492). Johnson's primary attachment of said decorative section includes a pin, and a friction element of said head section includes a material to frictionally secure said pin. Johnson does not disclose the material used in the head section. However, the applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). As it concerns claim 5, Johnson's assembly includes a threaded pin, and the primary attachment of the head section includes external threading. However, the applicant is reminded that the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

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14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 4,195,492) in view of Kowalski (U.S. Patent No. 5,074,128). Johnson discloses a body decoration system having a body piercing section comprising a straight rod. Kowalski discloses an earring teaching the use of a curved rod as a body piercing section. The applicant is reminded that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Response to Arguments

15. Applicant's arguments, see Paper No. 5, filed 12/13/02, with respect to the rejection(s) of claim(s) 1-17, 19-24, and 27-31 under have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hernandez (U.S. Patent No. 4,783,974), Erickson (U.S. Patent No. 4,781,036), Johnson (U.S. Patent No. 4,195,492), and Kowalski (U.S. Patent No. 5,074,128).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sakata (U.S. Patent No. 5,622,061) and Cannon (U.S. Patent No. 5,577,396) disclose the present invention substantially as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinesh N Melwani whose telephone number is 703-305-4546.


The examiner can normally be reached on M-F, 8:30-6 except every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-4115.

DNM
April 9, 2003



WILLIAM MILLER
PRIMARY